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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128

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EXAMINER	
NEURAUTER, GEORGE C	
ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/337,546	HIROOKA, SHIGEKI	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,8,10-16,22,24-30,36 and 38-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,8,10-16,22,24-30,36 and 38-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 2, 8, 10-16, 22, 24-30, 36, and 38-40 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 11 March 2005 have been fully considered but they are not persuasive.

Applicant argues that Tso and "RFC 1521" do not teach or suggest determining whether each part included in a received e-mail can be processed, by comparing the identified data type of each part with a registered utilizable data type, (2) storing a part that can be processed, included in the received e-mail, if it is determined that the part can be processed, and (3) deleting a part that cannot be processed, included in the received e-mail, if it is determined that the part cannot be processed. The Examiner does not agree. Tso discloses:

"The following discussion provides still more examples of the types of information which may be used to dictate which of transcode service providers 24 are invoked...The predetermined selection criterion may comprise...(6) user preferences, including preferred content quality/speed tradeoff, language, content rating, exclusion list, inclusion list, data type-specific preferences (for example, "never download" images), include/exclude advertising, amount of advertising desired,

offensive language removal, whether the user's defined or learned preferences may be disclosed (and to whom), custom rules or programs for filtering/transcoding/processing data, and shared preferences with either another user or a group of users (any of the foregoing user preferences may be explicitly defined or system predicated, such as based on usage statistics compiled over time)" (column 7, lines 15-54, specifically lines 15-21 and 45-54)

Therefore, the determining whether each part included in a received e-mail can be processed or "transcoded" as described in Tso, by comparing the identified data type of each part with a registered utilizable data type or "predetermined selection criterion" is discloses in Tso. Further, Tso discloses wherein the storing of the part if it is determined the part can be processed and deleting a part if it is determined the part cannot be processed or "data type-specific preferences (for example, "never download" images)" as shown in Tso. Tso discloses wherein the image is stored or "downloaded" if the image part can be processed as determined by the preference and the image is not stored or "deleted" if the image is not to processed or "never download". The limitation "processed" is interpreted in its broadest reasonable interpretation as required by MPEP 2131 by the Examiner and determining whether a

part can or cannot be processed is interpreted to mean that the determination process involving the "predetermined selection criterion" decides whether the part is processed or not. Therefore, based on the claim's broadest reasonable interpretation, the combined teachings of Tso and "RFC 1521" teach the limitations of the claim as cited in the previous Office Action and as shown here.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 421 733 B1 to Tso et al in view of "Request for Comments 1521: MIME (Multipurpose Internet Mail Extensions) Part One" ("RFC 1521").

Regarding claim 1, Tso discloses a processing method comprising the steps of:

identifying a data type of each part included in a text of a received packet, the received packet being a multi-part packet ("MIME"); (column 10, lines 37-49, specifically lines 37-44)

determining whether each part included in the received packet can be processed, by comparing the identified data type of each part with a registered utilizable data type; storing a part that can be processed, included in the received packet, if it is determined in said determining step that the part can be processed (column 10, lines 37-49, specifically lines 44-49); and

deleting a part that cannot be processed, included in the received packet, if it is determined in said determining step that the part cannot be processed. (column 2, lines 47-49; column 10, lines 37-49, specifically lines 44-49).

Tso does not expressly disclose wherein the method uses e-mail, however, Tso does disclose that the method uses MIME to perform the invention (column 6, lines 37-41).

"RFC 1521" discloses that MIME is used in conjunction with e-mail (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message..." and paragraph beginning "In particular, this document...").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tso to use email as disclosed in "RFC 1521" within the context of the steps disclosed. "RFC 1521" discloses that MIME enables e-mail to be reformatted to allow text and non-text e-mail parts to be sent together without losing any information (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message...", lines 3-5 and paragraph beginning "In particular, this document...") In view of the specific advantages disclosed in "RFC 1521" regarding the use of MIME and wherein both references disclose the use of MIME, one of ordinary skill would have appreciated the specific advantages disclosed in "RFC 1521" and would have found it obvious to modify Tso to accomplish the method disclosed in Tso using e-mail as disclosed in "RFC 1521" based on the specific references to MIME in both references.

Regarding claim 2, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses the method further comprising the step of:

registering data types that can be processed, in advance, wherein it is determining step that a part can be processed when the identified data type of the part coincides with a registered data type ("predetermined selection criterion"; column 7, line 15-column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically "...interrogating a MIME type in the content-type header record...if parser 22 detects a method for a predetermined selection criterion...").

Regarding claim 8, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a presence of a part that cannot be processed is notified to a user (column 8, line 51-column 9, line 10, specifically column 9, lines 7-10).

Regarding claim 10, Tso and "RFC 1521" disclose a method according to claim 1.

Tso disclsoes wherein, when it has been determined that a part cannot be processed, a subsequent process is selectable from a plurality of predetermined processes. (column 7, line 15-column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically lines 44-49)

Regarding claim 11, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part that can be processed is a text. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 12, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part that can be processed is an image. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 13, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein identification of a data type is performed by analyzing the received packet. (column 10, lines 37-49, specifically lines 37-44)

Tso does not disclose wherein the method uses e-mail.

Claim 13 is rejected since the motivations regarding the obviousness of claim 1 also apply to this claim.

Regarding claim 14, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part is identified in said identifying step according to a reference character string specified based on a position of a predetermined

character string in the received email ("content-type header record"; column 10, lines 37-49, specifically lines 37-44).

Claims 15-16, 22, and 24-28 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1-2, 8, and 10-14 respectively.

Claims 29-30, 36, and 38-40 are rejected since these claims recite a computer-readable storage medium storing control software that contain substantially the same limitations as recited in claims 1-2, 8, and 10, and 13-14 respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER